

The patent examination process: what the examiner is looking for

JAMES & WELLS
**CHAMPIONS
OF INNOVATION.**

For a New Zealand patent application to be examined the applicant is required to request examination of the application within five years of the date of filing the complete application or within two months from being issued a Direction to Request Examination by the Intellectual Property Office of New Zealand (IPONZ).

During examination, IPONZ determines if the application complies with the requirements of the Patents Act 2013. If it does not, the examiner will object to the application. It may be possible to overcome these objections either by argument or by amending the application (or both).

In New Zealand a patent applicant must respond to each examination report by the deadline set by IPONZ in each report (typically six months for a first examination report and three months for subsequent reports).

In addition the application must be placed in order for acceptance within 12 months of the date of issue of the first examination report.

The most commonly raised objections in an examination report are discussed below.

Not an invention

The Patents Act obliges examiners to determine whether the subject matter of the claims is patentable subject matter in New Zealand.

For more information read our information sheet: ['Patentable subject matter in New Zealand'](#).

Excluded subject matter currently includes human beings and biological processes for their generation, methods of medical treatment of humans, computer programs where the actual contribution made by the invention lies solely in it being a computer program, business methods which do not involve the essential use of a tangible apparatus or subject matter which is deemed contrary to morality (such as the use of human embryonic tissue or processes for cloning humans).

Contents of a complete specification

Title

The examiner will issue an objection if the title does not adequately identify the subject matter of the invention (e.g. the title may be overly broad) or if it does not correspond to the title on a corresponding patent application from which the application claims priority (e.g. a Patent Cooperation Treaty (PCT) application).

Drawings

Any drawings supplied with the specification must be capable of being reproduced clearly and must not include any written description. The examiner may require amendment to exclude such description (which can be added into the body of the specification if necessary).

Description

The specification needs to describe the invention and the best method of performing the invention known to the applicant at the date of filing the complete specification. The examiner may require further detail to be added to the body of the specification if he or she considers there is insufficient detail to enable a skilled reader to produce or perform the invention without the need for undue experimentation or further invention.

Formal correctness of the claims

The claims should use language which is clear and succinct (i.e. without excessive repetition of phrases) and which is supported by the material described in the specification at the time of filing.

Repetition or duplication of claims should also be avoided.

Unity of Invention

The claims need to relate to a single invention. If they do not, the examiner may require amendment or deletion of any claims which describe additional inventive concepts. The deleted claims may be included in a separate divisional application.

For more information read our information sheet: [‘Divisional Patent Applications: What are they and why should you use them?’](#)

Novelty and Inventive Step

For an invention to be a patentable invention it must be novel and involve an inventive step when compared with the prior art.

The prior art includes all information (including documents, products and processes) that has at any time prior to the filing date of the application been made publically available

anywhere in the world. Usually the examiner will search for patent documents or websites that pre-date the patent application.

In response to a novelty or inventive step objection the applicant must either amend the claims so that the invention they describe is novel and inventive over these disclosures and/or provide arguments distinguishing the disclosures in the cited documents from the invention claimed.

Duty to inform examiner of search results

If corresponding overseas patent applications have been filed, the applicant, if requested to do so, must advise the examiner of the results of searches conducted by the foreign patent offices. This duty remains until the New Zealand patent has been granted.

Next stage

Provided the requirements of the Act have been met, the application is accepted for grant. The accepted complete specification is then published in the Patent Office Journal and, providing no opposition is filed by a third party, it is sealed and granted.

Disclaimer

The above is provided for general information purposes only and does not take the place of specific legal advice. For more specific advice on all aspects of intellectual property law please contact us.